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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,305	12/23/2003	Toshihiko Ima	64903-023	5559

7590 02/16/2006  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/743,305	INA ET AL.	
	Examiner	Art Unit	
	Mark J. Beauchaine	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-17, 19 and 20 are currently pending in the instant application. Via amendment dated 28 November 2005, the Applicant has amended claims 1, 15 and 16, canceled claim 18 and added new claim 20.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claim recites the limitation "management module" in line 2. There is insufficient antecedent basis for this limitation in the claim. It appears that the Applicant intended for said claim to depend from claim 19 in lieu of claim 6.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Patent Application Publication Number WO 00/23952-A1 by Lundblad et al (hereinafter "Lundblad") published 27 April 2000 in view of US Patent

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Application Publication Number US 2006/0010071 A1 by Jones et al (hereinafter "Jones") published 12 January 2006. The banknote processing apparatus disclosed by Lundblad incorporates deposit compartment 10, unit 16-18, validation checking means 11 and process unit 12 that read on the Applicant's money-in module, counterfeit collection box, discrimination module and counterfeit processing module, respectively.

Furthermore, Lundblad discloses a process of printing a receipt including information related to both the banknotes processed and the customer performing the transaction (page 4, lines 28 plus) that reads on the Applicant's notification module. Although Lundblad fails to specifically disclose a copy of said printed receipt being forward to said customer the use of such receipts is well known in the art. It would have been obvious to one of ordinary skill in the art to provide a customer with transaction data in the form of a written receipt to provide said customer with a means of updating personal records and to authenticate monetary transactions.

Regarding claim 1, although Lundblad fails to disclose notifying a customer of the total amount of money received and settled in a transaction regardless of the results of counterfeit detection, it is well known in the art to notify customers of transaction data involved with counterfeit detecting apparatus. Jones teaches currency processing apparatus that incorporates a scanning device that obtains a customer's identity (paragraph 0057 lines 5 plus), recognizes counterfeit bills deposited by the customer (paragraph 0058, lines 3 plus) and ties the customer with the bills deposited (paragraph 0063, lines 8 plus). Furthermore, Jones teaches the option of a bank deducting or not deducting the amount of counterfeit bills from an account (paragraph 0147, lines 3 plus).

It would have obvious to one of ordinary skill to notify a customer of the results of such a transaction to inform said customer with the status of the customer account. This transaction process reads on the Applicant's customer notification via notification module.

Regarding claims 13 and 14, Lundblad discloses packaging unit 18 that produces currency bundles which read on the Applicant's bundles.

Regarding claims 15 and 16, the tying of customer identification with counterfeit bill transactions of Jones reads on the Applicant's mapping of customer identification with counterfeit banknotes involved with transactions. It would have been obvious to one of ordinary skill to incorporate the customer identification/counterfeit bill detection configuration of Jones into the banknote processing apparatus of Lundblad to provide an effective means of law enforcement to identify potential counterfeiters.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundblad in view of Jones as applied to claim 1 above, and further in view of Patent Number US 6,481,620 B1 by Katou et al (hereinafter "Katou"). Although Lundblad fails to disclose a temporary storage box the use of temporary currency holding means is well known in the art. Katou teaches a bill processing apparatus that incorporates a temporary storage box 400 to temporarily contain bills evaluated by discriminating unit 30. Said box 400 reads on the Applicant's temporary storage box. It would have been obvious to one of ordinary skill in the art to incorporate the temporary storage box 400 of Katou into the processing apparatus of Lundblad to provide an

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effective means of placing banknote in escrow during processing and prior to distribution based upon a determination of the bill characteristics.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Patent Application Publication Number US 2004/0028266 A1 published 12 February 2004 because of its counterfeit detection controller 150, and

Patent Application Publication Number US 2004/0153408 A1 published 5 August 2004 because of its image scanner 18.

Applicant's arguments with respect to claims 1-17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571)272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjb



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